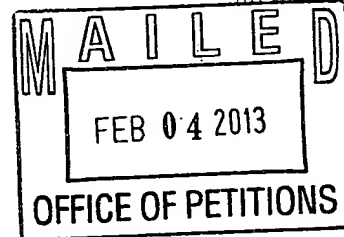




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Nixon Peabody LLP
PO BOX 60610
Palo Alto CA 94306

In re Application of :
Tanay et al. :
Application No. 09/636,044 :
Patent No. 6,636,044 : DECISION ON PETITION
Filed: August 10, 2000 : PURSUANT TO 37 C.F.R.
Issue Date: November 26, 2002 : § 1.378(B)
Attorney Docket No. 3757-1 :
Title: SYSTEM AND METHOD FOR :
FREQUENCY PLANNING IN WIRELESS :
COMMUNICATION NETWORKS :

This is a decision on the petition filed on January 29, 2013, pursuant to 37 C.F.R. § 1.378(b) to reinstate the above-identified patent.

This petition pursuant to 37 C.F.R. § 1.378(b) is **DISMISSED**.

Background

The patent issued on November 26, 2002. The grace period for paying the 7½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on November 26, 2010, with no payment received. Accordingly, the patent expired on November 26, 2010 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;

- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

With this petition, Petitioner has included, *inter alia*, the surcharge associated with a petition to accept the late payment of a maintenance fee as unavoidable, the 7½-year maintenance fee, a statement of facts, and copies of various e-mails.

The first and second requirements of 37 C.F.R. § 1.378(b) have each been satisfied. The third requirement of 37 C.F.R. § 1.378(b) has not been satisfied, as will be discussed below.

The standard

35 U.S.C. § 41(c)(1) states, *in pertinent part*:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay¹ is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.²

¹ This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

² *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912) (*quoting Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), *aff'd*, 143 U.S.P.Q. 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913).

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."³

The burden of showing the cause of the delay is on the person seeking to revive the application.⁴

**Application of the standard to the current facts and
circumstances**

The Assignee of record is an Israeli company by the name of Schema Ltd. (hereinafter referred to as "Schema"). With this petition, Petitioner has explained that Schema "used Israeli Counsel Sanford Colb law offices"⁵ (hereinafter referred to as "Colb law firm"), who utilized the law firm of Brown Raysman Millstein Felder & Steiner LLP (hereinafter referred to as "Brown law firm") as US counsel. Petitioner further explains that on an unspecified date, the Brown law firm merged with a law firm named Thelen Reid & Priest LLP to form a law firm named Thelen Reid Brown Raysman & Steiner LLP, which dissolved in October of 2008.⁶ Petitioner has further asserted that multiple attorneys from Thelen Reid Brown Raysman & Steiner LLP were hired by the law firm of Nixon Peabody,⁷ and has suggested that as a result, "responsibility appears to have been ultimately assigned to Nixon Peabody."⁸

Petitioner asserts that "each of the successive US correspondent firms was responsible for tracking maintenance fee deadlines associated with the patent, and to communicate them to Colb Office, which was, in turn, to communicate the deadlines to Schema Ltd," however Schema "did not receive a reminder of those deadlines."⁹ Petitioner further asserts that the Colb law firm "also tracked the deadlines for Schema,"¹⁰ in addition to the aforementioned various US firms.

³ Haines v. Quigg, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

⁴ Id.

⁵ Petition, page 1.

⁶ Petition, page 1 and Footnote 1 on page 2.

⁷ Footnote 1 on page 2.

⁸ Petition, pages 1 - 2.

⁹ Id. at 2.

¹⁰ Id. at 3.

Petitioner also asserts that on February 23, 2012, Schema was acquired by TEOCO Ltd., which is asserted to be "the current patent owner,"¹¹ which retained Petitioner to seek the reinstatement of this patent.

It is noted that no concurrently-submitted statement from any member of Schema, TEOCO Ltd., the Colb law firm, the Brown law firm, Thelen Reid Brown Raysman & Steiner LLP, or Nixon Peabody has been located in the electronic file.

The period for paying the 7½-year maintenance fee without the surcharge extended from November 26, 2009 to May 26, 2010 and for paying with the surcharge from May 27, 2010 to November 26, 2010. Thus, the delay in paying the 7½-year maintenance fee extended from November 26, 2010 at midnight to the filing of this petition on January 29, 2013.

Patentee has provided an indication of the date and manner by which the purported Assignee became aware of the expiration of the patent,¹² and a description of the steps taken to file the petition promptly.¹³

The record does not contain a showing that the delay was unavoidable, as will now be pointed out.

The record does not contain an enumeration of the steps taken to ensure timely payment of the maintenance fee. An adequate showing that the delay in payment of the maintenance fees at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fees, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b).

Petitioner has asserted that three separate US law firms were successively responsible for tracking the maintenance fee for this patent on behalf of Schema (the Brown law firm, Thelen Reid Brown Raysman & Steiner LLP, and Nixon Peabody). In addition to the aforementioned successive law firms, the Colb law firm

11 Id. at 3 - 4.

12 Id. at 3.

13 Id. at 3-5.

tracked the maintenance fee on behalf of Schema as well.¹⁴ However, it does not appear that Petitioner was associated with this patent until December 24, 2012,¹⁵ and as such, Petitioner does not appear to have firsthand knowledge of the facts set forth in this petition. On renewed petition, **Petitioner should include a statement of facts from members of both Schema and TEOCO Ltd, which comments on the accuracy of the assertions contained in this petition**, particularly whether either/both relied on the Brown law firm, Thelen Reid Brown Raysman & Steiner LLP, Nixon Peabody, and the Colb law firm to track the maintenance fees for this patent.

Moreover, it is noted that a patent holder's reliance upon an attorney does not provide him with an absolute defense, but rather shifts the focus to whether the attorney acted reasonably and prudently.¹⁶ It is well established that a patent holder is bound by any errors that may have been committed by his attorney.¹⁷ Petitioner will need to establish that any alleged failure of the Brown law firm, Thelen Reid Brown Raysman & Steiner LLP, Nixon Peabody, and the Colb law firm could not have been avoided with the exercise of due care. Whether an action by an attorney constituted a breach of the fiduciary duty of care is of no moment to the issue of whether the entire delay was unavoidable.¹⁸

On renewed petition, **Petitioner should include statements from members of the Brown law firm, Thelen Reid Brown Raysman & Steiner LLP, Nixon Peabody, and the Colb law firm.** Each statement should:

- confirm that the law firm was responsible for tracking maintenance fee deadlines associated with this patent, and include the dates during which the law firm tracked the maintenance fees;
- contain a description of the steps which were in place for ensuring the timely submission of the maintenance fee;

¹⁴ *Id.* at 3.

¹⁵ *Id.* at 5.

¹⁶ *California Medical Products v. Technol Med. Prod.*, 921 F. Supp. 1219, 1259 (D. Del. 1995).

¹⁷ *Smith v. Diamond*, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing *Link v. Wabash Railroad Co.*, 370 U.S. 626, 8 L. Ed. 2d 734 (1962)).

¹⁸ See *Haines v. Quigg*, 5 USPQ2d 1130 (N.D. Ind. 1987) (the court, in affirming an Office decision denying revival of an application on the basis of unavoidable delay, stated: "If the attorney somehow breached his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [attorney's] action or inaction with regard to the patent application.")

- contain an explanation of why the maintenance fee was not submitted in a timely manner;
- contain a description of the system each has in place for tracking maintenance fees, and;
- contain an explanation of why their system failed in this instance.

It is noted in passing that Petitioner has alleged that "Patent Owner" failed to receive "any communication from the USPTO attempting to notify the patent owner of the failure to pay the maintenance fee."¹⁹ Petitioner will note that MPEP § 2590(I) sets forth, *in pertinent part*:

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, *supra*. See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Conclusion

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision, and extensions of time under 37 C.F.R. § 1.136(a) are **not** permitted. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in 37 C.F.R. § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that Petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay,

¹⁹ Petition, page 2.

setting forth the facts as they know them. Petitioner must provide documentation and address the deficiencies noted above. If on request for reconsideration, the delayed payment of the maintenance fees is not accepted, then the maintenance fees are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.378(e)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,²⁰ hand-delivery,²¹ or facsimile.²² Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.²³

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Inquiries pertaining to the submission of maintenance fees should be directed to the Maintenance Fee branch at 571-272-6500.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to the address which appears on the petition. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of Correspondence Address, Patent

20 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

21 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

22 (571) 273-8300: please note this is a central facsimile number.

23 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Form (PTO/SB/123), may be found at
<http://www.uspto.gov/web/forms/sb0123.pdf>.

If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540.

A blank fee address form may be found at
<http://www.uspto.gov/web/forms/sb0047.pdf>.



Paul Shanoski
Senior Attorney
Office of Petitions

cc: Ralph P. Albrecht
Albrecht Tousi & Farnum PLLC
1701 Pennsylvania Ave., NW
Suite 300
Washington, DC 20006